

REMARKS

The following remarks attend to each outstanding issue raised by the Examiner in the pending May 8, 2002 office action. The indication of allowable subject matter in claims 16, 17, 57 and 58 is appreciated. No claims are canceled; accordingly claims 1-83 are pending in this application, claims 1 and 43 being independent.

Claim rejections - 35 U.S.C §102

Claims 1, 18, 20, 21, 23, 24, 26, 43, 50, 51, 53, 59, 61, 62, 64, 65, 67 and 68 stand rejected as being anticipated under 35 U.S.C. §102(e) by U.S. Patent No. 6,182,857 ("Hamm"). Applicants respectfully disagree and traverse the rejection since, among other reasons, Hamm is not prior art to the inventions of claims 1, 18, 20, 21, 23, 24, 26, 43, 50, 51, 53, 59, 61, 62, 64, 65, 67 and 68. Applicants enclose a declaration under 37 C.F.R. §1.131 and MPEP 715 to antedate Hamm. The declaration specifically shows conception of the invention prior to the effective date (December 31, 1998) of Hamm and due diligence from this conception to the effective filing date of this present application (the '631 Application).

Accordingly, we have shown why Hamm is avoided and inapplicable as prior art to the present '631 Application. For these reasons and more, Applicants contend that claims 1, 18, 20, 21, 23, 24, 26, 43, 50, 51, 53, 59, 61, 62, 64, 65, 67 and 68 are allowable and request reconsideration.

Claim rejections - 35 U.S.C §103

Claims 2-8, 27-29, 42, 44-53, 60-62, 69, 70 and 83 stand rejected as being unpatentable over U.S. Patent No. 5,934,439 ("Kano") in view of Hamm, under 35 U.S.C. §103. Applicants respectfully disagree and traverse the rejection since, among other reasons, Hamm is not prior art to the inventions of claims 2-8, 27-29, 42, 44-53, 60-62, 69, 70 and 83, as set forth in the attached Rule 131 declaration.

Kanoh also does not render claims 2-8, 27-29, 42, 44-53, 60-62, 69, 70 and 83 *prima facie* obvious. The following is a quotation of from the MPEP setting forth the three basic criteria that must be met to establish a *prima facie* case of obviousness:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP, § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Among other reasons, for example, Kanoh does not teach each and every feature of claims 2-8, 27-29, 42, 44-53, 60-62, 69, 70 and 83, and cannot therefore anticipate or render these claims obvious. Reconsideration is requested.

As applied to Applicants' claim 2, claims 30-32, 71 and 72 stand rejected as being unpatentable over Kanoh in view of Hamm, and further in view of U.S. Patent No. 5,822,291 ("Brindze"), under 35 U.S.C. §103. Applicants respectfully disagree and traverse the rejection since, among other reasons, Hamm is not prior art to the inventions of claims 30-32, 71 and 72, as set forth in the attached Rule 131 declaration.

Kanoh and Brindze also do not render claims 30-32, 71 and 72 *prima facie* obvious, since, among other reasons, Kanoh and Brindze fail to teach every element of claims 30-32, 71 and 72. Reconsideration is requested.

Claims 9-12 and 19 stand rejected as being unpatentable over Hamm in view of U.S. Patent No. 4,915,205 ("Reid"), under 35 U.S.C. §103. Applicants respectfully disagree and traverse the rejection since, among other reasons, Hamm is not prior art to the inventions of claims 9-12 and 19, as set forth in the attached Rule 131 declaration.

Reid also does not render claims 9-12 and 19 *prima facie* obvious, since, among other reasons, Reid fails to teach every element of claims 9-12 and 19. Reconsideration is requested.

Claims 13, 54, 55 and 56 stand rejected as being unpatentable over Hamm in view of U.S. Patent No. 5,938,510 (“Takahashi”), under 35 U.S.C. §103. Applicants respectfully disagree and traverse the rejection since, among other reasons, Hamm is not prior art to the inventions of claims 13, 54, 55 and 56, as set forth in the attached Rule 131 declaration.

Takahashi also does not render claims 13, 54, 55 and 56 *prima facie* obvious, since, among other reasons, Takahashi fails to teach every element of claims 13, 54, 55 and 56. Reconsideration is requested.

As applied to claim 2, claims 14 and 15 stand rejected as being unpatentable over Kanoh in view of Hamm, and further in view of Takahashi, under 35 U.S.C. §103. Applicants respectfully disagree and traverse the rejection since, among other reasons, Hamm is not prior art to the inventions of claims 14 and 15, as set forth in the attached Rule 131 declaration.

Kanoh and Takahashi also do not render claims 14 and 15 *prima facie* obvious, since, among other reasons, Kanoh and Takahashi fail to teach every element of claims 14 and 15. Reconsideration is requested.

Claims 22, 36-38, 63, 77-79 stand rejected as being unpatentable over Hamm in view of U.S. Patent No. 6,289,322 (“Kitchen”), under 35 U.S.C. §103. Applicants respectfully disagree and traverse the rejection since, among other reasons, Hamm is not prior art to the inventions of claims 22, 36-38, 63, 77-79, as set forth in the attached Rule 131 declaration.

Kitchen also does not render claims 22, 36-38, 63, 77-79 *prima facie* obvious, since, among other reasons, Kitchen fails to teach every element of claims 22, 36-38, 63, 77-79. Reconsideration is requested.

Claims 25, 34, 35, 66, 75 and 76 stand rejected as being unpatentable over Hamm in view of U.S. Patent No. 5,724,521 (“Dedrick”), under 35 U.S.C. §103. Applicants respectfully

disagree and traverse the rejection since, among other reasons, Hamm is not prior art to the inventions of claims 25, 34, 35, 66, 75 and 76, as set forth in the attached Rule 131 declaration.

Dedrick also does not render claims 25, 34, 35, 66, 75 and 76 *prima facie* obvious, since, among other reasons, Dedrick fails to teach every element of claims 25, 34, 35, 66, 75 and 76. Reconsideration is requested.

Claims 33, 73 and 74 stand rejected as being unpatentable over Hamm in view of U.S. Patent No. 5,900,608 ("Iida"), under 35 U.S.C. §103. Applicants respectfully disagree and traverse the rejection since, among other reasons, Hamm is not prior art to the inventions of claims 33, 73 and 74, as set forth in the attached Rule 131 declaration.

Iida also does not render claims 33, 73 and 74 *prima facie* obvious, since, among other reasons, Iida fails to teach every element of claims 33, 73 and 74. Reconsideration is requested.

Claims 39-41 and 80-82 stand rejected as being unpatentable over Hamm in view Iida, under 35 U.S.C. §103. Applicants respectfully disagree and traverse the rejection since, among other reasons, Hamm is not prior art to the inventions of claims 39-41 and 80-82, as set forth in the attached Rule 131 declaration.

Iida also does not render claims 39-41 and 80-82 *prima facie* obvious, since, among other reasons, Iida fails to teach every element of claims 39-41 and 80-82. Reconsideration is requested.

In summary, we have shown why claims 1-83 patentably distinguish over the art and that Hamm is inapplicable as a prior art 35 U.S.C. §102(e) reference to these claims. Reconsideration and allowance of claims 1-83 is hereby requested.

Claim rejections - 35 U.S.C §112

Claim 35 stands rejected due to antecedent basis of "advertisements." Claim 35 is amended to correctly depend from claim 34, obviating this rejection since advertisements is clearly recited in claim 34. Reconsideration is requested.

Claim 76 stands rejected due to antecedent basis of "advertisements." Claim 76 is amended to correctly depend from claim 75, obviating this rejection since advertisements is clearly recited in claim 75. Reconsideration is requested.

Other than the petition for the three-month extension of time, no fees are deemed due in connection with this response. If however any additional fee is due in connection with this response, please charge Deposit Account No. 12-0600.

Respectfully submitted, ✓

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

24. (Once amended) The system of claim 23, wherein said instructions for directing said second set of instructions further comprises:

instructions for directing said second processor to[:] record information of each said optical storage media that said user requests.

35. (Once amended) The system of claim [33]34, wherein said advertisements are promotions for optical media available at said kiosk.

65. (Once amended) The method of claim 64, further comprising the step of:
recording information of each said optical storage media that said user requests in said user profile.

76. (Once amended) The method of claim [43]75, wherein said advertisements are promotions for optical media available at said kiosk